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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/475,391	12/30/1999	CARLOS A. SILVA JR.	06975/048001	6275
26171	7590	12/12/2002	EXAMINER	
FISH & RICHARDSON P.C. 1425 K STREET, N.W. 11TH FLOOR WASHINGTON, DC 20005-3500			BAUGH, APRIL L	
		ART UNIT		PAPER NUMBER
		2143		

DATE MAILED: 12/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/475,391	SILVA ET AL.
Examiner	Art Unit	
April L Baugh	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
**THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
  - 2a) This action is **FINAL**.      2b) This action is non-final.
  - 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- Disposition of Claims**
- 4) Claim(s) 1-18 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
  - 5) Claim(s) \_\_\_\_\_ is/are allowed.
  - 6) Claim(s) 1-18 is/are rejected.
  - 7) Claim(s) \_\_\_\_\_ is/are objected to.
  - 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 December 1999 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e)-(to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5-7</u> . | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: pg.8, line 23, 27, and 29 reference 620 and pg. 11, line 6 reference 500b. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Fig. 2, reference 204,206, and 207, Fig. 5, reference 508, Fig. 6 reference 615, Fig. 7 reference 702, Fig. 11 reference 1104 and 1106, Fig. 12a reference 1200, 1202, and 1210, and Fig.12b reference 1200, 1210. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
3. Figure 4 and 5 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1, 4, 5, 7, 10, 12, 13, 15-18 rejected under 35 U.S.C. 102(b) as being unpatentable by US Patent 5,694,163 to Harrison.

Referring to claim 1, Harrison teaches a method of assigning a user to a network chat room, the chat room for distributing messages received from chat room members to other chat room members (column 1, lines 31-34 of Harrison), the method comprising: determining television programming viewed by a network user at a networked device; and assigning the network user to a chat room corresponding to the determined television programming (column 2, lines 27-38 of Harrison).

Regarding claim 4, Harrison teaches the method of claim 1, wherein the network comprises the Internet (column 1, lines 31-32 of Harrison).

Referring to claim 5, Harrison teaches the method of claim 1, wherein the chat room comprises a chat room for a particular television show (column 1, lines 12-14 of Harrison).

Regarding claim 7, Harrison teaches the method of claim 1, further comprising receiving a message from a network user assigned to the chat room and distributing the received message to other chat room members (column 1, lines 31-34 of Harrison).

Referring to claim 10, Harrison teaches a method of assigning a user to a chat room, the method comprising: providing a user interface that displays television programming (column 2,

lines 62-67 of Harrison); transmitting identification of the television programming displayed on the user interface to a network server; and presenting a chat room on the user interface that includes messages received by the network server from other users viewing the television programming (column 1, lines 31-34 and column 2, lines 27-38 of Harrison).

Regarding claim 12, Harrison teaches the method of claim 10, wherein transmitting identification comprises transmitting a television network identifier (column 2, lines 27-30 of Harrison).

Referring to claim 13, Harrison teaches the method of claim 1, wherein transmitting identification comprises transmitting an identifier of a particular television program (column 1, lines 12-14 of Harrison).

Regarding claim 15, Harrison teaches the method of claim 1, wherein transmitting identification comprises transmitting identification in response to user interaction with a user interface element (column 5, lines 65-67 through column 6, line 1 of Harrison).

Referring to claim 16, Harrison teaches a system for assigning a person to a chat room, the system comprising: server software resident on a network server (column 5, lines 18-23 of Harrison), the software (column 1, lines 12-14 of Harrison) including: instructions for distributing messages received from chat room members to other chat room members (column 1, lines 31-34 of Harrison); instructions for providing chat rooms corresponding to different television programming; and instructions for determining the television programming tuned to by a networked device that receives television programming; and assigning a network user using the networked device to a chat room based on the determined television programming; and, client software residing on the networked device, the client software including: instructions for

transmitting identification of the television programming being displayed by the networked device; and instructions for displaying chat room messages submitted by other chat room members (column 2, lines 27-38 of Harrison).

Regarding claim 17, Harrison teaches a computer program (column 1, lines 12-14 of Harrison), disposed on a computer readable medium, for assigning a user to a network chat room, the chat room for distributing messages received from chat room members to other chat room members, the program including instructions for causing a processor to: determine television programming viewed by a network user at a networked device; and assign the network user to a chat room corresponding to the determined television programming (column 2, lines 27-38 of Harrison).

Referring to claim 18, Harrison teaches a computer program (column 1, lines 12-14 of Harrison), disposed on a computer readable medium, for assigning a user to a chat room, the program including instructions for causing a processor to: provide a user interface that displays television programming; transmit identification of the television programming to a network server; and present a chat room that includes messages received by the network server from other users viewing the television programming (column 1, lines 31-34 and column 2, lines 27-38 and column 2, lines 62-67 of Harrison).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 2, 6, and 11 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,694,163 to Harrison in view of Moncreiff.

Referring to claim 2, Harrison teaches the method of claim 1, and determining television programming (column 2, lines 27-38 of Harrison).

Harrison does not teach determining comprises determining based on a channel tuned to by the networked device. Moncreiff teaches determining comprises determining based on a channel tuned to by the networked device (column 2, lines 4-10 of Moncreiff). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the method and apparatus for viewing of on-line information service chat data incorporated in a broadcast television program of Harrison by determining comprising determining based on a channel tuned to by the networked device because the channel the user is watching has the television program the user is interested in chatting about.

Regarding claim 6, Harrison teaches the method of claim 1, and the chat room (column 2, lines 27-38 of Harrison).

Harrison does not teach chat room comprises a chat room for a particular network. Moncreiff teaches chat room comprises a chat room for a particular network (column 2, lines 18-20 of Moncreiff). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the method and apparatus for viewing of on-line information service chat data incorporated in a broadcast television program of Harrison by having the chat room comprise a chat room for a particular network because the user wants to chat with a selective group of people with similar interest and profile to them.

Referring to claim 11, Harrison teaches the method of claim 10, and transmitting identification (column 2, lines 27-38 of Harrison).

Harrison does not teach transmitting identification comprises transmitting a channel number. Moncreiff teaches transmitting identification comprises transmitting a channel number (column 2, lines 4-10 of Moncreiff). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the method and apparatus for viewing of on-line information service chat data incorporated in a broadcast television program of Harrison by transmitting identification comprises transmitting a channel number because the channel the user is watching has the television program the user is interested in chatting about.

8. Claim 3 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,694,163 to Harrison in view of Schindler.

Regarding claim 3, Harrison teaches the method of claim 1, and the networked device (column 1, lines 12-14 of Harrison)

Harrison does not teach the networked device comprises a set-top box that receives television programming. Schindler teaches the networked device comprises a set-top box that receives television programming (column 2, lines 6-9 of Schindler). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the method and apparatus for viewing of on-line information service chat data incorporated in a broadcast television program of Harrison by having the networked device comprises a set-top box that receives television programming because this allows the user to watch the television program and chat about the program at the same time.

Referring to claim 14, Harrison teaches the method of claim 1, and transmitting identification (column 2, lines 27-38 of Harrison).

Harrison does not teach transmitting identification comprises transmitting identification in response to a change of channel. Schindler teaches transmitting identification comprises transmitting identification in response to a change of channel (column 1, lines 66-67 through column 2, lines 1-4 of Schindler). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the method and apparatus for viewing of on-line information service chat data incorporated in a broadcast television program of Harrison by transmitting identification comprising transmitting identification in response to a change of channel because if the user changes the channel then the new channel the user is watching has the television program the user is currently interested in chatting about.

9. Claim 8 and 9 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,694,163 to Harrison in view of Trovato et al.

Regarding claim 8, Harrison teaches the method of claim 1, and the chat room (column 2, lines 27-38 of Harrison).

Harrison does not teach determining whether to assign a person to a chat room. Trovato et al. teaches determining whether to assign a person to a chat room (column 2, lines 5-11 of Trovato et al.). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the method and apparatus for viewing of on-line information service chat data incorporated in a broadcast television program of Harrison by determining whether to assign a person to a chat room because this creates load balancing in the system versus allowing everyone to chat at their leisure.

Referring to claim 9, Harrison teaches the method of claim 8, and the chat room (column 2, lines 27-38 of Harrison).

Harrison does not teach determining whether to assign comprises determining how recently the user was last assigned to a chat room. Trovato et al. teaches determining whether to assign comprises determining how recently the user was last assigned to a chat room (column 5, lines 34-36 and 64-66 of Trovato et al.). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the method and apparatus for viewing of on-line information service chat data incorporated in a broadcast television program of Harrison by determining whether to assign comprises determining how recently the user was last assigned to a chat room because this will allow others who have not chatted recently a chance to chat about television programs that interest them.

### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with respect to chat rooms in general:

US Pat No. 6,434,599 to Porter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April L Baugh whose telephone number is 703-305-5317. The examiner can normally be reached on Monday-Friday 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on 703-308-5221. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-746-9149 for regular communications and 703-746-9149 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

ALB  
December 9, 2002



DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100